REMARKS

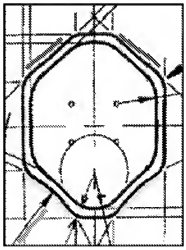
After entry of this Amendment, claims 40 – 53 are pending in the application. Claims 52 and 53 have been added and are directed to the elected invention shown in Figures 1 – 4. Claim 44 has been amended. Reconsideration of the application as amended is requested.

Claim 41 recites *the first range and the second range operably associated with one another whereby the hollow tube is operable to provide tactile feedback to a user of the hollow tube as to the orientation of the hollow tube in the user's hand.* The capacity of the hollow tube to provide tactile feedback because of the arrangement of the various wall thicknesses was set forth in the application as filed in several paragraphs, including paragraphs [0007] and [0027], for example. The prior art of record fails to disclose or suggest this feature and therefore fails to render claim 41 unpatentable.

The terms "operably associated" and "operable" are recognized as acceptable for claiming how structural elements are related to one another to perform a designated function. In Innova/Pure Water Inc. v. Safari Water Filtration Systems Inc., 72 USPQ2d 1001, 1006 (CAFC 2004), the Court stated that "[operable] . . . is a general descriptive term frequently used in patent drafting to reflect a functional relationship between claimed components." The term "associated" was also considered by the Court in Innova/Pure Water. The Court stated that "the word 'associated' merely reflects that the recited elements be joined in some kind of relationship." Id. at 1009. The decision in Innova/Pure Water also demonstrates that the function designated by the terms "operably associated" and "operable" is given patentable weight. As applied to the present matter, Innova/Pure Water requires that the function of

providing "tactile feedback to a user of the hollow tube as to the orientation of the hollow tube in the user's hand" be given patentable weight.

The Haute stick disclosed in the archived web-page discloses that tactile feed back is not accomplished by wall thickness. Page 2 of the NPL discloses a "[f]inger groove in front for tactile feel". Page 4 of the NPL states "[t]he curved edges are fitted for fingers [sp] tip grip and sensitivity" and "finger curves help identify which is the front". The drawing of the cross-section of the Haute stick is shown below. The "curved edges" are highlighted in yellow. These edges must be the referenced curved edges since (1) all of the remaining edges, including the opposing edges highlighted in red, are straight, and (2) a radius arrow, highlighted in green, is shown pointing to that edge. Thus, Haute provides tactile feedback only because two outwardly facing surfaces are shaped differently than the remaining outwardly facing surfaces, not because of arranging various wall thicknesses.



With respect to wall thickness, the NPL states that "more metal [is put] in the corners" and "the shaft has a much greater wall thicknesses on the edges than on the flats" at page 3. As a result, "tiny I-beams [are created] in *every* corner." Id. (emphasis added). With reference to the cross-sectional drawing above, every corner is thickened so there would be no possibility of the thinner and thicker wall thicknesses being associated together such that the Haute stick would be operable to provide tactile feedback as to the orientation of the hollow tube in the user's hand. Specifically, the mass of the stick is evenly distributed about centerline axis, portions of thicker wall (corners) separated by portions of thinner wall. Every corner defines a concentration of mass and the corners are substantially evenly distributed about the axis. If the distribution in the wall thickness did in fact provide tactile feedback, the addition of the curved edges for finger tips would be redundant and unnecessary.

Haute has been combined with Merola to reject the claims under 35 U.S.C. § 103. This rejection is also traversed. Merola expressly and unambiguously acknowledges that the ball bat fails to provide tactile feedback. At column 1, Merola discloses:

> swaged can thereby be used and the body of the bat kept within acceptable weight limits. An indicia cam be placed on the bat to assist a batter in properly orienting it, as is now done with wood bats where orientation of the wood grain is recommended.

At column 3, Merola again acknowledges the failure of the ball bat to provide tactile feedback:

> grain. A suitable external marking can be provided on the ball bat of the present invention is assisting the batter to align the bat properly.
> After the body 11 has been formed the vibration-

As set forth above, claim 41 recites that the first range and the second range are ***operably associated*** with one another (working together in some kind of relationship) whereby the hollow

tube is ***operable to*** provide tactile feedback to a user of the hollow tube as to the orientation of the hollow tube in the user's hand (the designated function). The language carries patentable weight and must be found in the prior art to render the claim unpatentable.

The rejection as applied to each of claims 42 – 48 and 50 is also traversed:

- The wall thickness of neither the Haute stick nor the Merola bat is constant over 180 degrees as recited in claim 42, or over 120 degrees as recited in claim 43. Applicants respectfully submit that there is no requirement under the law that unexpected or surprising results must be identified for a claim feature that is not disclosed in the prior art. Unexpected or surprising results can be proffered to traverse a valid prima facie rejection for obviousness – a valid prima facie rejection for obviousness still requires that all the claimed features are shown in the prior art. This is not the case for claim 42 or claim 43.
- It is submitted that the amendment to claim 44 defines over the art. Neither Haute nor Merola teach or suggest a cross-section of two ranges of constant, but different, wall thicknesses separated by a relatively narrow transition range.
- With respect to claim 45, Merola does not indicate that any portion of Figure 5 represents a constant wall thickness. The Figure itself appears to show a wall thickness that continuously changes about the centerline of the bat. The line representing the inner surface is a circle off-center from the circle representing the outer surface, necessarily implying that the wall thickness changes continuously about the centerline of the bat.
- The rejection as applied to claims 46 – 48 and 50 is traversed for the same reason set forth in support of claims 42 and 43: unexpected results are not a requirement of

patentability. Proof of unexpected results can overcome a valid prima facie rejection for obviousness. However, a valid prima facie rejection for obviousness must come first. One of the requirements of a valid prima facie case of obviousness, even after KSR, is that all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. The art of record fails to teach or suggest the limitations set forth in claims 46 – 48 and 50.

New claims 52 and 53 have been added to the application. These claims depend from claim 41, the elected invention. The structural features recited in claims 52 and 53 are shown in Figure 4 and therefore supported by the disclosure as originally filed. The specification has been amend in accordance with M.P.E.P. § 608.01(o), which instructs the applicant to amend the specification whenever nomenclature in the specification is departed from in order to have clear antecedent basis in the specification.

It is submitted that the amendments have antecedent basis in the application as filed and that the amendments do not add new matter to the application. It is further submitted that the amendments place the claims of the application in suitable condition for allowance; notice of which is respectfully requested. If the Examiner believes that prosecution of the application can be expedited by way of an Examiner's amendment, the Examiner is invited to contact the Applicants' attorney at the telephone number listed below.

The under-signed attorney is acting pursuant to M.P.E.P. § 405.

Respectfully submitted,

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